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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/518,922

12/23/2004

Ryuichi Oota

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EXAMINER

WILLIAMS, JAMILA O

ART UNIT

PAPER NUMBER

3722

NOTIFICATION DATE

DELIVERY MODE

12/03/2007

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com  
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## Office Action Summary

Application No.

10/518,922

Applicant(s)

OOTA, RYUICHI

Examiner

Jamila Williams

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-7 and 12 is/are rejected.
- 7) ☒ Claim(s) 3,4,8-11 and 13-18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>12-23-04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Objections***

Claim 1 is objected to because of the following informalities: there appears to be a typographical error in line 5 of the claim with the phrase "in the retained in the adhesive tank...for applying the to a sheet..". Appropriate correction is required.

Claim 18 is objected to because there is a period missing from the end last line of the claim. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by 3,397,351 to DeMand.

DeMand discloses a bookbinding apparatus comprising a moveable adhesive tank (35) for retaining therein an adhesive melted by heat (column 4 lines 65-67), a roller (42) rotatably supported with the tank so as to dip a lower portion thereof retained in the adhesive tank (figure 3), for applying the adhesive to a sheet stack along a lateral edge thereof (figure 3), a holding unit capable of holding the sheet stack (3,7), an adhesive tank carrier for disposing the adhesive tank and roller at a stand-by-position located outside a longitudinal end face of the sheet stack held by the holding unit in a stand by

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stage and moving the adhesive tank and roller together from the stand by position in a longitudinal direction of the sheet stack substantially through an entire area under a back face thereof in a book binding stage (column 4 lines 35-47), a non-contact heater for contactlessly heating the adhesive tank disposed at the stand-by position to melt the adhesive (coil 47 which is connected to the base of the adhesive tank but does not contact the adhesive), as recited in claim 1.

Claim 12 is rejected under 35 U.S.C. 102(b) as being anticipated by 6,432,511 to Davis et al (hereinafter Davis).

Davis discloses an adhesive pellet in a substantially spherical shape (column 5 lines 25-26 discloses adhesive material in the form of a sphere). In that the structure of the adhesive is met, it is presumed to be inherently capable of the claimed functions (used with adhesive supply unit, usable in bookbinding apparatus).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over DeMand in view of JP 8-216549 to Kitazaki et al (hereinafter Kitazaki) and further in view of 5,219,453 to Furukawa et al (hereinafter Furukawa).

DeMand discloses the elements of the claims but for the heating coil being an electromagnetic induction heating coil and the tank containing a ferromagnetic material.

Kitazaki teaches an adhesive binding system that uses an electromagnetic heating coil and a holder (or broadly speaking a "tank") 7 made of aluminum which holds the adhesive and generates heat to the adhesive from the heating coil.

Furukawa provides a teaching that aluminum is a ferromagnetic material (column 8 lines 26-30).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the heating coil and material of Kitazaki and Furukawa with the binding device of DeMand for the purpose of melting the adhesive.

Alternatively, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use ferromagnetic material for the tank, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice. In re Leshin, 125 USPQ 416.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over DeMand.

DeMand discloses the elements of the claims but for the roller constituted of non-ferromagnetic material.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use non-ferromagnetic material for the roller, since it has been held to be within the general skill of a worker in the art to select a known material on the

basis of its suitability for the intended use as a matter of design choice. In re Leshin, 125 USPQ 416.

Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeMand in view of 5,003,916 to Donley.

DeMand discloses the elements of the claims but an inclined bottom wall in the adhesive retaining region of the adhesive tank and the adhesive tank being provided with a fin.

Donley discloses an inclined bottom wall (36) in the adhesive retaining region of the tank (figure 3), as recited in claim 6.

Donley discloses a tank with a fin (34) for promoting melting of adhesive (40) erected on a bottom wall in the adhesive region (figure 3), as recited in claim 7.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the inclined wall and fin of Donley with the adhesive tank of DeMand for the purpose of aiding in melting of the adhesive.

***Allowable Subject Matter***

Claims 3-4,8-11,13-18 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and to remove any objections set forth above.

**Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. This is simply art of interest and was not used to reject any claims in this office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamila Williams whose telephone number is 571-272-4431. The examiner can normally be reached on Monday-Thursday 6:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica Carter can be reached on 571-272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
JW 11-10-2007

  
MONICA CARTER  
SUPERVISORY PATENT EXAMINER